

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2****REMARKS****INTRODUCTION:**

In accordance with the foregoing, the specification has been amended to clarify the relationship between the instant application and a parent application and to correct an apparent typographical error, and claims 1, 4, 9-11, 16, 24, and 29 have been amended.

Claims 1-29 are pending and under consideration. Reconsideration is requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because:

- (1) it is believed that the amendments of claims 1, 4, 9-11, 16, 24, and 29 put this application into condition for allowance as suggested by the Examiner;
- (2) the amendments of claims 1, 4, 9-11, 16, 24, and 29 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and
- (3) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2****REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 2-4, the Examiner rejects claims 1, 3-6, 8, 11, and 29 under 35 U.S.C. §102 in view of Kaiiyama et al. (U.S. Patent No. 6,283,764). The rejection is traversed and reconsideration is respectfully requested.

While applicants do not agree with all aspects of the Examiner's characterization of Kaiiyama et al. as being consistent with that of one of ordinary skill in the art, the applicants respectfully submit that the prior art does not disclose or suggest at least that "the another area comprises a catalog management (CMG) region having management information on the catalog information, and a catalog title set (CTS) in which at least one catalog title including the catalog information related to each item of the audio data is recorded" as recited in claim 1.

It is respectfully submitted that the prior art does not disclose or suggest the invention recited in claims 4, 11, and 29 for at least similar reasons.

Claims 3, 5, 6, and 8 are deemed patentable due at least to their depending from corresponding claims 1 and 4.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 5-6, the Examiner rejects claims 2, 7, 12, and 13 under 35 U.S.C. §103 in view of Kaiiyama et al. and Moriyama et al. (U.S. Patent No. 5,889,746). The rejection is traversed and reconsideration is respectfully requested.

Even assuming arguendo that the Examiner is correct with regard to the disclosure of Moriyama et al., it is respectfully submitted that the Examiner does not rely on Moriyama et al. to cure the above noted defect of the prior art as applied to claims 1, 4, and 11, from which claims 2, 7, 12, and 13 correspondingly depend. Therefore, it is respectfully submitted that the prior art does not disclose or suggest the invention recited in claims 2, 7, 12, and 13 due at least to their depending from claims 1, 4, and 11, respectively.

In the Office Action at pages 6-7, the Examiner rejects claims 9, 14, and 15 under

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2**

35 U.S.C. §103 in view of Kaiiyama et al. and Heo (U.S. Patent No. 6,222,983). The rejection is traversed and reconsideration is respectfully requested.

As an initial point of clarification, Heo appears to have an earliest U.S. filing date of August 29, 1997, and issued April 24, 2001. In addition, the instant application has an earliest U.S. filing date of March 8, 1999. Therefore, Heo appears to qualify as prior art under 35 U.S.C. §102(e)(2).

In addition, it is noted that Heo is commonly owned with the instant application. Under 35 U.S.C. §103(c), "[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP 2146, EXAMINATION GUIDELINES FOR 35 U.S.C. 102(E), AS AMENDED BY THE AMERICAN INVENTORS PROTECTION ACT OF 1999, AND FURTHER AMENDED BY THE INTELLECTUAL PROPERTY AND HIGH TECHNOLOGY TECHNICAL AMENDMENTS ACT OF 2002, AND 35 U.S.C. 102(G), 1266 OG 77 (January 14, 2003). Therefore, it is respectfully submitted that Heo is not available as prior art for use in an obviousness rejection under 35 U.S.C. §103.

As such, even assuming arguendo that the Examiner is correct with regard to the disclosure of Kaiiyama et al., it is respectfully submitted that the Examiner does not assert that Kaiiyama et al. discloses the features of claims 9, 14, and 15 without Heo. Thus, it is respectfully submitted that the prior art does not disclose or suggest the invention recited in claims 9, 14, and 15.

In the Office Action at pages 7-10, the Examiner rejects claims 16-18, 20, 23, 26, and 27 under 35 U.S.C. §103 in view of Kaiiyama et al. and Mimura et al. (U.S. Patent No. 5,963,704). The rejection is traversed and reconsideration is respectfully requested.

For reasons similarly set forth above with regard to the rejection of claim 1, it is respectfully submitted that the prior art does not disclose or suggest at least that "the another

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2**

area comprises a catalog management (CMG) region having management information on the catalog information, and a catalog title set (CTS) in which at least one catalog title including the catalog information related to each item of the audio data is recorded" as recited in claim 16.

Even assuming arguendo that the Examiner is correct with regard to the disclosure of Mimura et al., it is therefore respectfully submitted that the Examiner does not rely on Mimura et al. to cure the above noted defect of the prior art as applied to claim 16. Thus, it is respectfully submitted that the prior art does not disclose or suggest the invention recited in claim 16.

Claims 17, 18, 20, 23, 26, and 27 are deemed patentable due at least to their depending from claim 16.

In the Office Action at pages 10-11, the Examiner rejects claims 19, 21, 22, and 25 under 35 U.S.C. §103 in view of Kaiiyama et al., Mimura et al., and Heo. The rejection is traversed and reconsideration is respectfully requested.

As similarly noted with regard to the rejection of claim 9, it is respectfully submitted that Heo is not available as prior art for use in an obviousness rejection under 35 U.S.C. §103. As such, even assuming arguendo that the Examiner is correct with regard to the disclosure of the combination of Kaiiyama et al. and Mimura et al., it is respectfully submitted that the Examiner does not assert that the combination of Kaiiyama et al. and Mimura et al. discloses the features of claims 19, 21, 22, and 25 without Heo. As such, it is respectfully submitted that the prior art does not disclose or suggest the invention recited in claims 19, 21, 22, and 25.

In the Office Action at page 11, the Examiner rejects claim 28 under 35 U.S.C. §103 in view of Kaiiyama et al., Mimura et al., and Moriyama et al. The rejection is traversed and reconsideration is respectfully requested.

Even assuming arguendo that the Examiner is correct with regard to the disclosure of Moriyama et al. and Mimura et al., it is respectfully submitted that the Examiner does not assert that the combination of Moriyama et al. and Mimura et al. cures the above noted deficiency of the prior art as applied to claim 16, from which claim 28 depends. As such, it is respectfully

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2**

submitted that the prior art does not disclose or suggest the invention recited in claim 28 due at least to the prior art not disclosing or suggesting the invention recited in claim 16.

STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION

On page 12 of the Office Action, the Examiner objects to claims 10 and 24 as depending from rejected claims. Claims 10 and 24 have been made independent and have not been amended to narrow the scope of the claims. As such, it is respectfully requested that the Examiner reconsider the objection.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

SERIAL NO. 09/923,323**DOCKET NO. 1293.1059CIPD2**

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: 

James G. McEwen
Registration No. 41,983

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

Date: Dec 24, 2003